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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/887,523	06/21/2001	Joel L. Passke	005127.00094	5745

22907 7590 08/19/2003
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[REDACTED] EXAMINER

STASHICK, ANTHONY D

[REDACTED] ART UNIT

PAPER NUMBER

3728

DATE MAILED: 08/19/2003

17

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 17

Application Number: 09/887,523
Filing Date: June 21, 2001
Appellant(s): PASSKE ET EL.

MAILED
AUG 19 2003
GROUP 3700

Byron S. Kuzara
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 25, 2003.

(1) *Real Party in Interest*

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A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-3, 6-10, 12-14 and 16 do not stand or fall together, 4 stands or falls alone, 5 and 11 stand or fall together, and 15 stands or

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falls alone, and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) ClaimsAppealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,845,417	Reed et al.	12-1998
FR 2,670,369	Colesnicenco Niculae	06-1992
EP 1,704,193	Opal Limited	02-2001

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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2. Claims 1-16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reed et al. 5,845,417 in view of the European reference to Opal Limited 1,074,193 (Opal '193).

Reed et al. '417 discloses all the limitations of the claims including the following: an upper (see Figure 5); a sole structure 204 attached to the upper (see Figure 5); an air-filled bladder 210 in fluid communication with ambient air (surrounding air within the shoe) and attached to the article of footwear (attached to the sole); a filter 214 in fluid communication with the bladder and ambient air (see col. 8, lines 32-53 and 63-66 and col. 9, line 66 through col. 10, line 22); the filter being structured to permit ambient air to enter the bladder; the filter located in the sole. Reed et al. '417 does not teach that the filter can restrict liquids and particulates from entering the bladder, the material makeup of the filter, a perforated layer located over the filter. Opal '193 teaches that a filter 26 for filtering the air that is received within a bladder of a shoe can be made of a material, such as Gore-Tex® which is known to be made of expanded polytetrafluoroethylene, which would allow for the shoe to breathe, letting air and liquid vapor out of the shoe while allowing air into the shoe. Opal '193 also teaches that a perforated layer 22 can be located on top of the filter to aid

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in ventilation while preventing large debris from entering the upper. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the filter of Reed et al. '417 out of Gore-Tex®, as taught by Opal '193, to allow for the bladder to let air into the shoe and allow for the escape of air and vapor from the shoe bladder. It also would have been obvious to place a perforated layer, such as that shown Opal '193, over the Gore-Tex® layer, as taught by Opal '193, to protect the Gore-Tex® layer from being damaged while allowing more air into the bladder and preventing large particles from entering the bladder.

3. Claims 1-14 and 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over the French reference to Colesnicenco Niculae 2,670,369 (Colesnicenco '369) in view of the European reference to Opal Limited 1,074,193 (Opal '193). Colesnicenco '369 discloses a sole structure; an air-filled bladder 6 in fluid communication with ambient air (through 1-3) and attached to the article of footwear (see Figure 6); a filter 1 in fluid communication with the bladder and ambient air (see Figures); the filter being structured to permit ambient air to enter the bladder; the filter being located in the upper. Colesnicenco '369 does not teach that the filter can restrict liquids and particulates from entering the bladder.

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Colesnicenco '369 does not teach that the filter can restrict liquids and particulates from entering the bladder, the material makeup of the filter, a perforated layer located over the filter or the filter located in the sole of the shoe. Opal '193 teaches that a filter 26 for filtering the air that is received within a bladder of a shoe can be made of a material, such as Gore-Tex® which is known to be made of expanded polytetrafluoroethylene, which would allow for the shoe to breathe, letting air and liquid vapor out of the shoe while allowing air into the shoe. Opal '193 also teaches that a perforated layer 22 can be located on top of the filter to aid in ventilation while preventing large debris from entering the upper. Therefore, it would have been obvious, to make the filter of Colesnicenco '369 out of Gore-Tex®, as taught by Opal '193, to allow for the bladder to let air into the shoe and allow for the escape of air and vapor from the shoe bladder. It also would have been obvious to place a perforated layer, such as that shown Opal '193, over the Gore-Tex® layer, as taught by Opal '193, to protect the Gore-Tex® layer from being damaged while allowing more air into the bladder and preventing large particles from entering the bladder.

(11) Response to Argument

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For ease of following the arguments presented here, the response to the arguments made by the appellant will be lettered and numbered the same as that in appellant's brief.

(8) *First Issue- Response to the argument directed to the combination of Reed and Opal*

Appellant argues that the combination of Reed and Opal is improper because the filter of Reed allows for the passage of fluid whereas Opal does not. This argument is not clearly understood. Reed states in col. 9, line 66-col. 10, line 7 that air is drawn through the filter and into the intake tube 258 then the air and/or liquid then passes through the intake valve 264 and through the monotube 260 into the pump cell. This clearly describes the moisture/water/fluid already being located within the shoe and not entering through the filter. Clearly Reed et al. is all about not allowing fluid/water from entering the shoe of the user and making it uncomfortable and is about the difficulty and trying to solve the difficulty of removing moisture buildup in the shoe (due to perspiration and heat from the user's foot). Therefore, since Reed et al. is concerned with the removal of moisture from the shoe, Reed et al. would certainly not want to add any more fluid/water/moisture to the shoe. Opal is concerned with allowing the user's foot to

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breathe, i.e. ventilate, without allowing fluid to enter the shoe but allows vapor to escape the shoe to prevent fluid build-up in the shoe. Therefore, since both references are solving similar problems, the removal of heat and moisture build-up in the shoe without adding to the problem by adding fluid to the shoe, the references are combinable. The combining of Reed et al. with the material of Opal would allow the sole of Reed et al. to breathe and prevent fluid from entering the shoe sole. Using the PTFE of Opal as the filter in Reed et al. would also allow for the water vapor to escape the shoe, thereby preventing the build-up of fluid in the sole.

(8) Second Issue- Response to Argument of No Proper Motivation to Combine Colesnicsenco and Opal.

Appellant argues that the use of felt or another filtering material, as taught in Colesnicsenco, does not teach or suggest the use of a filter that is structured to restrict passage of liquids through filter material. This argument is not clearly understood. The claims require only that the material "restrict" liquids and particulates from entering the bladder. As such, the felt filter disclosed by Colesnicsenco would restrict the passage of fluids and particulates but would not "prevent" the flow of fluids and particulates from entering the

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bladder. Since the appellant is concerned with only restricting and not preventing this flow of fluids and particulates, Colesnicsenco's material would meet this limitation in the claims.

Appellant further argues that Opal teaches using Gore-Tex® as a portion of the upper that allows air to flow into and out of the shoe upper and not as a filter. This argument is also not clear as it can clearly be seen that the Gore-Tex® material, known for having very small pores, would inherently filter out larger pores as well as fluid, the known purpose for using Gore-Tex® in footwear (to prevent the user's foot from getting wet).

Third Issue- Response to Arguments That elements of Claim 4 are not Disclosed.

Appellant argues that none of the references disclose a filter consisting of one of the group of high-density polyethylene, ultrahigh molecular weight polyethylene, polyvinylidene fluoride, polypropylene and ceramic filter materials. These materials are all known material used in filters and, as such, it would have been obvious to one of ordinary skill in the art to use known filter material for use as a filter for the bladder of Reed et al. or Colesnicsenco.

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Replacing one known filter for another would not be beyond the skill of one of ordinary skill in the art.

Fourth Issue- Response to the Arguments that the Elements of Claims 5 and 11 are not Disclosed.

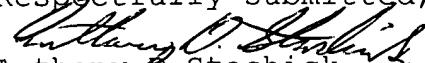
Appellant argues that none of the references disclose that the materials used are hydrophobic or oleophobic. The definition of hydrophobic is as follows "repelling, tending not to combine with, or incapable of dissolving in water." (Taken from The American Heritage Dictionary of the English Language. Third Edition copyright ©1992 by Houghton Mifflin Company.)

Therefore, taking the broadest reasonable interpretation of the term, since Gore-Tex® does not allow for water to pass through and therefore does not allow itself to be dissolved in water, then it is hydrophobic by nature. Also, since it does not allow for itself to be dissolved in oil (oleophobic), this would also be an inherent property of Gore-Tex®, thereby meeting the limitations in the claims.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,


Anthony D Stashick

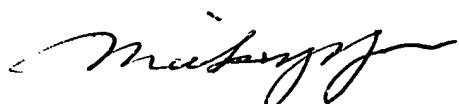
Primary Examiner

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ADS

August 18, 2003

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